UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,995	08/15/2001	Noah J. Ternullo	12078-142	9105

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EXAMINER
NANO, SARGON N

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 August 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 - 45</u> is/are pending in the application.

    4a) Of the above claim(s) <u>46</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) <u>1-45</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

1.   This office action is responsive to election/restriction received on August 25,

2005. Applicants elected with traverse claims of group I, which consist of claims 1, 3 –

20 and 22 – 45, therefore restriction is made final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 3 – 20, 22 – 45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hendrey et al. U. S. Patent No. 6,647,269 (referred to hereafter as

Hendrey) in view of Weiss at al U.S Patent No. 6,738,951 (referred to hereafter as

Weiss).

As to claim 1, Hendrey teaches a method for distributing utilizing an

advertisement for a service for accessing a service, the service being relevant to a

location to a client device at the location, said method comprising the steps of:

formatting ,outside the client device, unsolicited advertising information from the

advertisement , the unsolicited advertising information including (see col. 2 Lines 14 –

22, Hendrey discloses an advertisement received by a mobile device): service

information indicating the purpose of the advertisement (see col. 2 lines 14 – 22

Hendrey discloses mobile device enters the area of a corresponding to a certain

business);

data entry information indicating purchasing options based on the purpose (see

col. 2 lines 30 – 40 Hendrey discloses a user of a mobile device is associated with a

purchase at a store) ; and

contact information containing instructions for enabling the client device to

communicate, with the service; forming an advertising signal containing the unsolicited

advertising information (see col. 2 line 57 – col. 3 line 6, Hendrey discloses system

delivering advertisement to a mobile device) ;

propagating the advertising signal from a transmitter to the client device within

the location; receiving the advertising signal at the client device (see col. 2 line 57 – col.

3 line 6, Hendrey discloses system delivering advertisement to a mobile device);

decoding the advertising signal to extract the unsolicited advertising

information(see col. 2 line 57 – col. 3 line 6, Hendrey discloses system delivering

advertisement to a mobile device); displaying the unsolicited advertising information to

a user of the client device(see col. 2 line 57 – col. 3 line 6, Hendrey discloses system

delivering advertisement to a mobile device); and

determining, by the client device, a response to the advertising signal, based on

the unsolicited advertising information (see col. 2 line 57 – col. 3 line 6, Hendrey

discloses that user's device sending its location signal as a response based on the

advertisement information).

Hendry teaches the invention as mentioned above. Hendrey fails to explicitly

teach the Use of XML elements, However Weiss teaches a transcoding system for

delivering electronic document to a device using multiple digital formats such as XML,

(see abstract). It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to format the advertisement information into XML elements because it would offer greater flexibility in organizing and presenting information than is possible with other markup languages, such as HTML.

As to claim, 3 Hendrey teaches the method of claim 1 further comprising the steps of:

selecting the service based on the unsolicited advertising information and the response (see col. 2 line 57 – col. 3 line 6);

communicatively coupling the client device with the selected service as a result of said step of selecting(see col. 2 line 57 – col. 3 line 6); and

communicating the selection and the response to the selected service(see col. 2 line 57 – col. 3 line 6).

As to claim 4, Hendrey teaches the method of claim 3 further comprising the step of constructing a user interface for allowing the user to communicate with the client device (see col. 2 line 57 – col. 3 line 25).

As to claim 5, Hendrey teaches the method of claim 4 further comprising the step of receiving user inputs in response to the unsolicited advertising information (see col. 2line 57 – col. 3 line 6).

As to claim 6, Hendrey teaches the method of claim 5 further comprising the step of formatting the user inputs, the response, and a portion of the unsolicited advertising information into a user reply, the user reply for making the user inputs available to the service (see col. 2line 57 – col. 3 line 6).

As to claim 7, Hendrey teaches the method of claim 6 wherein the user reply is received at the transmitter (see col. 2line 57 – col. 3 line 6).

As to claim 8, Hendrey teaches the method of claim 7 wherein the user reply is received as a wireless signal from the client device (see col. 2line 57 – col. 3 line 6)..

As to claim 9, Hendrey teaches the method of claim 7 wherein the user reply is received at the transmitter using a communication interface providing electromechanical contact between the client device and the transmitter (see col. 2line 57 – col. 3 line 6)..

As to claim 10, Hendrey teaches the method of claim 9 further comprising the step of receiving a service response from the transmitter, the service response including, executable code for allowing the client device to interact with the service (see col. 2 line 57 –col. 3 line 6).

As to claim 11, Hendrey teaches the method of claim 6 wherein the user reply is sent directly from the client device to received at a point-of-presence (POP) (see col. 2 line 14 – 29).

As to claim 12, Hendrey teaches the method of claim 11 wherein the user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between the client device and the POP (see col. 2 line 57 –col. 3 line 6).

As to claim13, Hendrey teaches the method of claim 12 further comprising the step of receiving a service response from the POP, the service response including executable code for allowing the client device to interact with the service (see col. 2 line 57 –col. 3 line 6).

As to claim 14, Hendrey teaches the method of claim 1 wherein the advertisement is propagated as an optical signal through air (see col. 3 lines 9 – 26).

As to claim 15, Hendrey teaches the method of claim 14 wherein the optical signal has a wavelength in the range of 850 nanometers to 1250 nanometers (see col. 3 lines 9 – 26).

As to claim16, Hendrey teaches the method of claim 15 wherein the transmitter receives the advertisement over an Internet (see col. 3 lines 9 – 26).

As to claim 17, Hendrey teaches the method of claim 15 wherein the transmitter receives the advertisement over a fiber optic network (see col. 3 lines 9 – 26).

As to claim 18, Hendrey teaches the method of claim 1 wherein the client device is a personal digital assistant (PDA) (see col. 3 lines 9 – 26).

As to claim 19, Hendrey teaches a method for conveying unsolicited information comprising the steps of:

preparing the unsolicited information by a service including: service information indicating the purpose of the information (see col. 2 lines 14 – 22);

data entry information indicating purchasing options based on the purpose(see col. 2 lines 14 – 22); and

contact information containing instructions for enabling the client device to communicate with the service(see col. 2 line 57 – col. 3 line 6);

receiving the unsolicited information from the service into a transmitter outside the client device having a link layer(see col. 2 lines 14 – 22);

formatting the unsolicited information in the transmitter for transmission to a client

device operating within a context associated with the transmitter(see col. Lines 14 – 22);

and

conveying the unsolicited information from the transmitter to the client device

over a communication medium (see col. 2 line 57 – col. 3 line 6).

As to claim 20, Weiss teaches the method of claim 19 wherein the unsolicited

information is comprised of an XML element. Hendrey fails to explicitly teach the Use of

XML elements, However Weiss teaches a transcoding system for delivering electronic

document to a device using multiple digital formats such as XML, (see abstract). It

would have been obvious to one of the ordinary skill in the art at the time of the

invention was made to format the advertisement information into XML elements

because it would offer greater flexibility in organizing and presenting information than is

possible with other markup languages, such as HTML.

As to claim 22, Hendrey teaches the method of claim 19 wherein the unsolicited

information is conveyed from the transmitter as a diffuse infrared signal (see col. 3 lines

9 – 25).

As to claim 23, Hendrey teaches the method of claim 22 wherein the diffuse

infrared signal has a wavelength in the range of substantially 850 nanometers to 1250

nanometers (see col. 3 lines 9 – 26).

As to claim 24, Hendrey teaches the method of claim 19 wherein the client

device includes a client device physical layer and a client device link layer compatible

with the link layer in the transmitter (see col. 2 line 57 – col. 3 line 6).

As to claim 25, Hendrey teaches a method for interacting with a service provider comprising the steps of:

receiving an unsolicited broadcast message having user-specific service information about a service from a service provider into a client device(see col. 2 lines 14 – 22);

creating, by the client device, an object-oriented service object from the service information(see col. 5 lines 12 – 32);

activating the client device, the service object (see col. 5 lines 12 – 32);

receiving, by the client device, user data into the service object(see col. 2 lines 14 – 22);

sending, by the client device, the user data to the service provider (see col.2 line 57 – col.3 line 6);

receiving, by-the client device, service provider data required to utilize the service from the service provider (see col. 4 line 46 – 61); and

displaying by the client device, the service provider data required to utilize the service (see col. 4 line 46 – 61);

As to claim 26, Hendrey teaches the method of claim 25 further comprising the step of: displaying an icon associated with the service object (see col. 5 lines 26 – 32).

As to claim 27, Hendrey teaches the method of claim 25 wherein the service provider data is displayed using a plug-in cooperatively associated with the service information (see col. 3 lines 17 – 33).

As to claim 28, Hendrey teaches the method of claim 27 wherein the plug-in further includes information about a preference of the user (see abstract).

As to claim 29, Hendrey teaches a method of utilizing executable code in a transmitter for providing an advertisement to a client device, said method comprising the steps of:

receiving the advertisement by the executable code in the transmitter from a service provider about a service offered by the service provider(see col. Lines 14 – 22);

formatting the advertisement by the executable code in the transmitter for transmission to the client device operating within a coverage area of the transmitter(see col. Lines 14 – 22); and

conveying the advertisement by the executable code in the transmitter from the transmitter to the client device over a communication medium(see col. 2 line 57 – col. 3 line 6).

As to claim 30, Weiss teaches the method of claim 29 wherein the advertisement is comprised of an XML element. Hendrey fails to explicitly teach the Use of XML elements, However Weiss teaches a transcoding system for delivering electronic document to a device using multiple digital formats such as XML, (see abstract). It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to format the advertisement information into XML elements because it would offer greater flexibility in organizing and presenting information than is possible with other markup languages, such as HTML.

As to claim 31, Hendrey teaches the method of claim 30 wherein the advertisement further comprises:

information enabling a user of the client device to make a decision about the service provider, the decision being based on the service information; data entry information informing the user about utilizing a service offered by the service provider; and contact information containing instructions for enabling the client device to communicate with the service provider (see col. 4 lines 46 – 55).

As to claim 32, Hendrey teaches the method of claim 29 wherein the advertisement is conveyed from the transmitter as a diffuse infrared signal (see col. 3 lines 9 – 26).

As to claim 33 Hendrey teaches the method of claim 32 wherein the diffuse infrared signal has a wavelength in the range of   850 nanometers to 1250 nanometers (see col. 3 lines 9 – 26).

As to claim 34, Hendrey teaches the method of claim 33 wherein the diffuse infrared signal is generated by modulating an electric light (see col. 3 lines 9 – 26).

As to claim 35, Hendry teaches a method of utilizing executable code in a client device receiving an unsolicited, formatted advertisement from a transmitter located outside the client device, said method comprising the steps of:

receiving the unsolicited, formatted advertisement from an infrared communication signal conveyed from the transmitter, wherein the transmitter formatted the advertisement, and arriving at a communication interface associated with the client

device, the unsolicited, formatted advertisement containing at least a portion of a

service offered by a service provider (see col. Lines 14 – 22, Hendrey discloses an

advertisement received by a mobile device);

decoding, the client device, the unsolicited, formatted advertisement to extract

information contained therein(see col. Lines 14 – 22, Hendrey discloses an

advertisement received by a mobile device);

relating, by the client device, the information to user-specific data in the client

device; and displaying, by the client device, the information related to the user-specific

data to a user of the client device(see col. Lines 14 – 22, Hendrey discloses an

advertisement received by a mobile device).

As to claim 36, Weiss teaches the method of claim 35 wherein said unsolicited,

formatted advertisement is comprised of an XML element. Hendrey fails to explicitly

teach the Use of XML elements, However Weiss teaches a transcoding system for

delivering electronic document to a device using multiple digital formats such as XML,

(see abstract). It would have been obvious to one of the ordinary skill in the art at the

time of the invention was made to format the advertisement information into XML

elements because it would offer greater flexibility in organizing and presenting

information than is possible with other markup languages, such as HTML.

As to claim 37, Hendrey teaches the method of claim 36 wherein the unsolicited,

formatted advertisement further comprises: service information enabling the user to

make a decision about the service, the decision based on the service information (see

col.2 line 57 – col. 3 line 6);

data entry information informing the user about utilizing the service; and contact information containing instructions enabling the client device to communicate with the service provider (see col.2 line 57 – col. 3 line 6).

As to claim 38, Hendrey teaches the method of claim 37 wherein the transmitter includes an emitter link layer (see col.2 line 57 – col. 3 line 6).

As to claim 39, Hendrey teaches the method of claim 38 wherein the client includes a client device link layer (see col.2 line 57 – col. 3 line 6).

As to claim 40, Hendrey teaches the method of claim 39 wherein the emitter link layer is compatible with the client device link layer (see col.2 line 57 – col. 3 line 6).

As to claim 41, Hendrey teaches the method of claim 40 wherein the information about the service is displayed to the user if the client device is running a plug-in cooperatively associated with the service (see col. 3 lines 17 – 33).

As to claim 42, Hendrey teaches the method of claim 41 wherein the plug-in further comprises information about a preference of the user (see col. 3 lines 17 – 33).

As to claim 43, Hendrey teaches the method of claim 25 further comprising the steps of:

displaying the service provider data on a wearable device; and

receiving user data from eye movement (see col. 3 lines 17 – 33).

As to claim 44, Hendrey teaches the method of claim 25 further comprising the steps of: displaying the service provider data on a device mounted in a vehicle; and receiving information pertaining to the location of the vehicle through an IR communication interface (see col. 3 lines 17 – 33).

As to claim 45, Hendrey teaches the method of claim 19 wherein the unsolicited information is conveyed from the transmitter as a radio frequency (RF) signal (see col. 3 lines 9 – 26).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. In the remarks applicants argue in substance that A) neither Hendry nor Weiss either separately or in combination disclose a response to the advertising information that a client device received. B) neither Hendry nor Weiss either separately or in combination disclose formatting outside the client device information into XML document.

In response to A) when the prospective user or potential customer responds to the tailored advertising message by walking into the store that is relevant to the advertisement that is received on the mobile unit of the prospective or user, then the user is responding to the unsolicited advertisement. Therefore, the claimed limitation is met (see Hendry col. 5 lines 25 – 55).

In response to B) Weiss teaches the documents are reformatted to and from XML outside the client device. Once the document is being transmitted a proxy server that resides outside the client device, reformats and transcodes the documents into XML, HTML etc. Therefore Hendry in view of Weiss still meet the scope of the limitation as currently claimed (see Weiss col. 4 lines 44 – 60).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sargon N. Nano whose telephone number is (571) 272-4007. The examiner can normally be reached on 8 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Sargon Nano
19 Aug. 2006

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